AMENDMENT TO THE DRAWINGS:

Please add new FIG. 3 as attached.

REMARKS

The above amendments and these remarks are responsive to the Office Action issued on May 16, 2006. By this response, the specification and claims 1, 3, 6, 9, 12 and 13 are amended. Claims 10, 11 and 14-29 are cancelled without prejudice. Claims 30-35 are newly presented. No new matter is introduced. Claims 1-9, 12, 13 and 30-35 are now active for examination.

The Office Action

The Office Action rejected claims 1-9 and 12-13 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 1-9 and 12-13 were rejected under 35 U.S.C. § 102(b) as being anticipated by the article entitled *"How to Search a WAIS Database"* (WAIS). The Examiner objected to claim 3 for formality reason. The drawings were objected to as allegedly not showing every feature of the invention specified in the claims.

Applicants respectfully submit that the rejection is overcome and the objection is addressed in view of the amendments and/or remarks presented herein.

Objections to the Drawings

The Office Action objected to the drawings for not showing every feature of the invention specified in the claims. The Examiner suggested adding a flow chart reflecting the features described in the claims. By this Response, a new drawing FIG. 3 is added as suggested by the Examiner. Descriptions corresponding to new FIG. 3 are also added. No new matter was added. Appropriate support for the amendment to the drawings and the specification can be found in, for example, original claim 1 as filed, paragraph [040] and paragraphs [087] through [097] of the written description. Entry of the amendments is respectfully requested.

Objection To Claim 3

The Examiner objected to claim 3 because of minor informalities. By this Response, claim 3 is amended as suggested by the Examiner. It is submitted that claim 3 is now in appropriate form.

Rejection Of Claims 1-9, 12 AND 13 Under 35 U.S.C. § 101

Claims 1-9, 12 and 13 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The rejection is overcome.

By this Response, all the independent claims are amended. It is submitted that the claims are not directed solely to mere ideas, laws of nature, or natural phenomena. Each of the claims falls squarely into one of the classes of subject matter permitted by 35 U.S.C. § 101, that is to say process or machine, respectively. Independent claim 6, for example, is tied to a data processing system (machine), in which elements are stored on a tangible medium upon which processing is performed. Independent claims 9 and 13, as amended, recite a tangible machine-readable medium, in conformity with *In re Beauregard,* 53 F.3d 1583, 35 USPQ2d 1383 (Fed. Cir. 1995). According to the Beauregard decision, computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. §101.

Also, each of the independent claims describes processing text items and generating representative text items of an active task being accessed by a user; or processing text items, generating a set of search terms, and initiating an information retrieval process using the generated search terms. It is respectfully submitted that generating representative text items or a set of search terms based on computer processing of information produces a "useful, concrete and tangible result" **analogous** to the transformation of discrete dollar amounts into a final share price, which the Federal Circuit found to be a sufficiently "useful, concrete and tangible result"

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in *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). Furthermore, generating representative text items or a set of search terms based on computer processing of information to <u>differentiate</u> between representative and non-representative text items produces a "<u>useful, non-abstract result</u>" **analogous** to the <u>method</u> of adding a data field with information on long distance providers, which the Federal Circuit found to be a "useful, non-abstract result that facilitates differential billing of long-distance calls," which "fall[s] comfortably within the broad scope of patentable subject matter under §101." *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

For reasons outlined above, it is submitted that all of the rejections under 35 U.S.C. § 101 should be withdrawn.

<u>Rejection Of Claims Under 35 U.S.C. § 102</u>

Claims 1-9 and 12-13 are rejected as being anticipated by the article entitled *"How to Search a WAIS Database"* (WAIS). The anticipation rejection is respectfully traversed because WAIS cannot support a prima facie case of anticipation.

In rejecting the claims based on the WAIS document, the Examiner failed to establish that the cited document was indeed published prior to the filing date of this application. <u>It is submitted that the Examiner has not discharged the duty in establishing a prima facie case of anticipation.</u>

Furthermore, it is submitted that WAIS fails to disclose every limitation of the claims. Claim 1, as amended, describes an adaptive method for obtaining representative text items from a plurality of text items in an active task being accessed by a user on a data processing system. The active task is a task other than entering search terms for the purpose of retrieving information. For instance, the active task is a Word document being manipulated by a user, <u>not</u>

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an input field for a user to enter search terms for a search engine. Each of the plurality of text items having <u>a plurality of attributes</u>. For each of the plurality of text items in the active task being accessed by the user, each of the plurality of attributes is identified. For each of the plurality of text items in the active task being accessed by the user, <u>a weight is assigned to each of the plurality of attributes</u>. At least two of the plurality of attributes are assigned different weights. For each of the plurality of text items in the active task being accessed by the user, <u>an accumulated weight is calculated by accumulating the weight assigned to each of the plurality of attributes</u>. The method ranks the plurality of text items in the active task being accessed by the user based on the accumulated weight of each of the plurality of text items. <u>Representative text items of the active task are generated based on a result of the ranking step</u>.

On the other hand, WAIS relates to a search engine that receives a user's search query, in natural language or in Boolean form, and searches for documents in a WAIS database that are most relevant to the search query. Each document is given a score from 1 to 1000, based on how well it matched the user's question. In order to determine the score of a document, words included in a document is compared with words in user's questions. For instance, if a word in a document is found to match a word in the user's question, the word I assigned a weight and this weight adds to the overall score of that document. If words in the user question are in the headline of a document in the WAIS database, or if the words appear many times, that document receives a higher score.

In rejecting claim 1, the Office Action did not specifically point out which element in WAIS corresponds to what claim element. <u>As the user interface in WAIS is the only field that a user of the WAIS search engine manipulates, it is assumed that the user's entry of search queries is analogous to the active task of claim 1, and that query words entered by the user are analogous to the text items recited in claim 1</u>. In processing the user's query, WAIS uses "stop words" to

remove insignificant words in the user's query. However, WAIS <u>fails</u> to teach that each of the plurality of text items (query words) in the active task having <u>a **plurality** of attributes</u>, and that a step is performed to identify each of the plurality of attributes for each of the plurality of text items, as described in claim 1. Since WAIS does not identify multiple attributes associated with each query word, WAIS does <u>not</u> assign a weight to <u>each of the plurality of attributes</u>, as described in claim 1. WAIS also <u>fails</u> to disclose "for each of the plurality of text items in the active task being accessed by the user, calculating an accumulated weight by <u>accumulating</u> the weight assigned to each of the plurality of attributes," as described in claim 1. WAIS also <u>fails</u> to teach <u>ranking the plurality of text items (query words) in the active task</u> being accessed by the user based on the accumulated weight of each of the plurality of text items, as described in claim 1.

It is noted that the Office Action heavily relied on paragraphs related to "Word Weight" and "Relevance Ranking." However, in WAIS, both the "Word Weight" section and the "Relevance Ranking" section are related to assigning weights to **documents** <u>that already exist in the WAIS database</u>, not text items included in an active task being accessed by a user, as described in claim 1. Furthermore, though WAIS allegedly identifies documents that possibly relate to the search query, WAIS does not generate any <u>representative text items of the search query being manipulated by the user</u>. Moreover, the claim amendment specifically differentiates claim 1 from WAIS by specifying that <u>the active task as recited in claim 1 is a task other than entering search terms for the purpose of retrieving information, such as a task for entering search queries into a search engine, as discussed in the WAIS document</u>. Thus, WAIS fails to disclose every limitation of claim 1, WAIS cannot support a prima facie case of anticipation. The anticipation rejection is untenable and should be withdrawn. Favorable reconsideration of claim 1 is respectfully requested.

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Claims 2-5, directly or indirectly, depend on claim 1 and incorporate every limitation thereof. Accordingly, claims 2-5 also are patentable over WAIS by virtue of their dependencies.

Independent claims 6 and 9 include descriptions substantially parallel to claim 1. Accordingly, claims 6 and 9 also are patentable over WAIS for at least the same reasons as for claim 1. Claims 7 and 8 depend on claim 6 and incorporate every limitation thereof. Therefore, claims 7 and 8 also are patentable based on their dependencies.

Claim 12 describes a method for retrieving information related to the context of <u>a data collection</u> including a plurality of text items. Each of the plurality of text items has a plurality of attributes. The method comprising the machine-executed steps of: (a) for each of the plurality of text items, identifying each of the plurality of attributes; (b) for each of the plurality of text items, assigning a weight to each of the plurality of attributes, wherein at least two of the plurality of attributes are assigned different weights; (c) for each of the plurality of text items, calculating an accumulated weight by accumulating the weight assigned to each of the plurality of attributes; (d) ranking the plurality of text items based on the accumulated weight of each of the plurality of text items; (e) generating a set of search terms containing a predetermined number of text items based on rankings of the plurality of text items; and (f) initiating an information retrieval process using the set of search terms to <u>retrieve data from a data source other than the data collection</u>.

As discussed earlier, in processing the user's query, WAIS uses "stop words" to remove insignificant words in the user's query. However, WAIS <u>fails</u> to teach that each of the plurality of text items (query words) having <u>a **plurality of attributes**</u>, and that a step is performed to identify each of the plurality of attributes for each of the plurality of text items (query words), as described in claim 12. Since WAIS does not identify multiple attributes associated with each query word, WAIS does <u>not</u> assign a weight to <u>each of the plurality of attributes</u>, as described in claim 12. WAIS also <u>fails</u> to disclose for each of the plurality of text items, calculating an

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accumulated weight by <u>accumulating</u> the weight assigned to each of the plurality of attributes," as described in claim 1. WAIS also <u>fails</u> to teach <u>ranking the plurality of text items (query words)</u> based on the accumulated weight of each of the plurality of text items, as described in claim 12.

Even assuming that the WAIS database is a data collection including a plurality of text items, WAIS only ranks the documents in the WAIS database according to their respective relevance to a search query, and does **not** <u>generate any **search terms** containing a predetermined number of text items</u> **based on** rankings of the text items included in the WAIS database. Moreover, claim 12, as amended, recites "initiating an information retrieval process using the set of search terms to retrieve data <u>from a data source other than the data collection.</u>" WAIS does not disclose this feature. If WAIS ever performs any information retrieval process, the process is performed to retrieve documents stored **in** the WAIS database (the data collection), not a data source **other** than the WAIS database. Accordingly, WAIS fails to disclose every limitation of claim 12. Withdrawal of the anticipation rejection of claim 12 is respectfully requested.

Claim 13 includes descriptions substantially parallel to claim 12. Therefore, claim 13 also is patentable over WAIS. Favorable reconsideration of claim 12 is respectfully requested.

New Claims 30-35 Are Patentable

New claims 30-35, directly or indirectly, depend on claims 1, 6 and 9, respectively, and further describe determining properties of the active task, wherein the assigned weight is tunable based on the properties of the active task, or the properties of the active task include at least one of application software being employed to perform the active task, the type or genre of the active task, attributes related to the user manipulating the active task, properties of an information source on which a search will be conducted, and the state of the active task. It is submitted that these features are not available in the documents of record. Accordingly, new claims 31-35 are

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patentable for at least the same reasons as for claims 1, 6 and 9, as well as based on their own merits. Favorable consideration of the new claims is solicited.
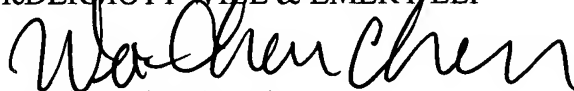
Conclusion

For the reasons given above, Applicants believe that this application is in condition for allowance, and request that the Examiner give the application favorable reconsideration and permit it to issue as a patent. If the Examiner believes that the application can be put in even better condition for allowance, the Examiner is invited to contact Applicants' representatives listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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